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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 41

Application Number: 08/813,852

Filing Date: March 07, 1997

Appellant(s): DOCKERY ET AL.

MAILED

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GROUP 3600

R. Ross Viguet
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 22, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 18-23 and 25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

2,215,163	SHEDD	9-1940
4,968,061	BULLARD, Jr.	11-1990
5,127,674	LAMPHERE et al.	07-1992

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims: Claims 18-23 and 25 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 38.

(11) *Response to Argument*

The appellants argue that the Declarations filed under 37 CFR 1.132 properly establish objective evidence of non-obviousness. It is the

examiner's position that the Declaration under 37 CFR 1.132 filed March 28, 2002 and the Supplemental Declaration filed April 1, 2002 by Caleb J. Pirtle with supporting letters from Judy Cole, Jeff Stone, Ken Summers and Roger King are insufficient to overcome the rejection of claims 18-23 and 25 based upon 35 USC 103(a) as set forth in this Office action because: the Declarations do not establish a nexus between the claimed invention and the evidence of commercial success. The term "nexus" designates a factually and legally sufficient connection between the evidence of commercial success and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licencing Ltd.* 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir. 1988). The Declaration, Supplemental Declaration and letters do not establish a nexus between the claimed invention and the commercial success because it is clear from the Declaration, Supplemental Declaration and letters that Dockery House Publishing is providing more services than just those of the claimed invention. Specifically, in the letter of Ken Summers it is stated that the editorial staff worked to tailor original articles and photography to showcase the products and in paragraph 2 of the

Declaration filed March 28, 2002, Mr. Pirtle states that he is involved in determining market trends and demands, that he works with customers to analyze their historic sales performance, their sales and marketing growth potential and their advertising or marketing budget needs. The commercial success must be derived from the claimed invention. In considering commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. *In re Mageli*, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled little weight); *In re Noznick*, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). The letters of Judy Cole, Roger King and Ken Summers provide opinions as to what motivates coupon redeemers but do not include any facts that the increased coupon redemption rate is due to the claimed invention. The letter of Judy Cole states that the

increased redemption rate is due to the product placement and corresponding coupons in general interest articles but it does not provide any statistics showing increased coupon redemption rate nor does it provide any evidence that any increase in coupon redemption is due to the claimed invention rather than the other services provided by Dockery House Publishing. The letter of Jeffery Stone provides no supporting evidence of the statements made therein; such as the statement that Dockery House Publishing techniques result in increased coupon redemption rates. Further, the letter of Jeffery Stone states that Lifestyle Vacation Incentives is moving to Dockery House Publishing, which is to say that they are projecting increases but have no past data to support their position. Likewise, the letter of Ken Summers provides no supporting evidence of the statements made therein and states re the opportunity to increase sales that: "Your promotional magazine can make that a real possibility.", which again is directed to the future rather than any past success. The letter of Roger King also speaks to the future as they announce that Dockery House will be our Publisher and includes no evidence of any past success.

The appellants argue that there is no requirement that an applicant for patent provide only a good or service related to an invention in order to prove commercial success. It is the examiner's position that a declaration establishing commercial success must establish a nexus between the claimed invention and the evidence of commercial success. That is, the declaration must show that the commercial success is due to the claimed invention and not any other services or activities.

In summary the Declaration and Supplemental Declaration of Caleb J. Pirtle and the letters of Judy Cole, Jeff Stone, Ken Summers and Roger King provide only future projections and opinions and conclusory statements that are not supported by facts and evidence.

Therefore, having considered the three factual inquiries specified in *Graham v. John Deere Co.*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2nd 545 (1966), 148 USPQ 459 and the factual allegations in the applicant's declaration in accordance with the provisions of 37 CFR 1.132, the rejections are deemed proper.

The appellants argue that there is not proper motivation to combine Shedd and Bullard and that there is nothing to suggest that magazines may be generally substituted for books as advertising media.

It is the examiner's position that the disclosure in col. 2, lines 27-33 of Bullard clearly suggests to one of ordinary skill in the art that the advertising method disclosed in Bullard is intended to be used in booklets, magazines or books. The combination of Shedd and Bullard as proposed in the rejections does not involve hindsight, since Bullard teaches that an advertising method that is usable in books is also useable in magazines.

The appellants argue that the rejections do not meet the claimed element that the magazine includes articles of general interest. It is the examiner's position that the recipes disclosed on page 2 in col. 1, lines 21-24 of Shedd are articles of general interest. Further, Shedd discloses on page 2 in col. 2, lines 12-15 that after removal of the coupons the book remains as a complete book with the contained matter usable at will the same as any other book. Therefore, the recipes have general interest even after removal of the coupons.

The appellants argue that the magazines of the present invention include full length feature articles. It is the examiner's position that the appellants may not have read into the claims features disclosed but not recited in the claims. The limitation full length feature article is not included in any of the claims on appeal. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The appellants argue that there is no hint or suggestion of the inclusion of brand specific information within the disclosure of Shedd.

It is the examiner's position that the disclosure on page 2 in col. 1, lines 21-45 of Shedd that the recipe and the coupon include a particular product of a distributor is disclosure of a brand or brands specific to the distributor. The disclosure of Shedd makes it clear that the distributor only honors the coupons of products that the distributor handles. In order for this to be true the brands that the distributor will honor coupons for must be identified.

The appellants argue that Lamphere does not teach a magazine for use in promoting the purchase of specific articles. It is the examiner's position that the rejection is not relying on Lamphere et al to teach a magazine for use in promoting the purchase of specific articles. Lamphere et al is relied upon to show a promotional booklet that is specific to a particular store. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The appellants argue that there is nothing in the applied art to meet the limitation that the article is authored under commission by a sponsor of the specific brand or a specific store. It is the examiner's position that the disclosure in col. 9, lines 5-12 of Lamphere et al is disclosure that the advertising space may be sold to advertisers of specific stores or to advertisers of specific brands. The writers of the advertisements, whoever they are, are of course paid by the advertisers. These are normal business practices, those who do work are compensated by those for whom the work is done.

The appellants argue that the examiner has not addressed the limitation that the name of the store appears on the cover of the magazine. The examiner notes that Shedd discloses on page 1 in col. 2, lines 23-26 that the cover of the book may bear the name of the distributor or the like and that the cover of the booklet in Fig. 4 of Lamphere et al includes the name of a supermarket.

The appellants argue that the references do not disclose that the content of the articles is controlled by a sponsor of the specific brand. It is the examiner's position that it is well known that whoever pays the piper calls the tune.

The appellants argue that the examiner has not addressed the limitation that at least one of the articles includes within its confines reference to specific brand information pertaining to other products. It is the examiner's position that the book of Shedd shows plural coupons and discloses a plurality of recipes in the book, see page 2 in col. 1, line 22. All the recipes, of course, would not include the same ingredients.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

fjb
October 17, 2002

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PRIMARY EXAMINER 12/18/02